

Response to Office Action of 12/12/2005

Application/Control Number 10/512,027

judged a single Claim by the U.S. Patent Office. This is the origin of the “*run on sentences*” asserted in the Rejection. The U.S. Patent Office did approve all the above patents—both old and recent—with no comment upon the language used to express the Claims. This is even the format used by Hardenstein (1,666,448), as cited in these Rejections, as well as all of the other patents cited in Section 7. Prior Art (see below.)

We would also like to point out that the U.S. Patent Office in the Preliminary Examination phase approved this patent (now known as A/C Number 10/512,027.) Such approval might have permitted the Claims to be “narrative”, as asserted. However, the examiners were not reticent in asking the Inventors to clarify the Claims, yet they never raised a concern that the Claims were “narrative”. More importantly, it is unlikely that the U.S. Patent Office would have approved the Preliminary Examination if the Claims were “indefinite” as asserted in the Rejection.

3. & 4. Claim Rejections – 35 USC § 102 Assertions:

The Claims 1-5 are rejected as being anticipated by Hardenstein (1,666,448).

3. & 4. Response:

Our inventions as described in Claims 1-20 of A/C Number 10/512,027 are not anticipated by Hardenstein, because Hardenstein does not describe the fabrication of tiles that are members of multiple series. The game described by Hardenstein is, like ours, a tile game. But all of our Claims 1-20 are distinct from the claims of Hardenstein. Since all of our Claims 2-20 are dependent on our Claim 1, it is sufficient to show that Claim 1 is not anticipated by Hardenstein.

It is true that Hardenstein has playing pieces that are largely square in shape, divided into four sections by diagonal lines from corner to corner. This is one format we also

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describe, and which is used in many patented tile games, but the contents of the sections in our game are completely different from those in any other game in the prior art.

Hardenstein describes a game in which the numbers on the pieces are matched to each other, as in the game of dominoes that arrived in Europe in the 18th century. The numbers or indicia on our pieces are all members of numerical series. We know of no game in the prior art that has pieces that are members of four or more numerical series.

The following elements of Claim 1 are *not* anticipated by Hardenstein:

- Playing pieces that are fabricated to be members of multiple numerical series. (Hardenstein does not indicate anything about numerical series, and his playing pieces are not members of any series.)
- Playing pieces that are members of series that run from 1 to 9, and then start at 1 again, creating an indefinitely long series.
- Playing pieces that are simultaneously members of four series.
- Playing pieces that are simultaneously members of an even number of series, where that number is greater than four.
- Playing pieces that have pairs of elements, all of which sum to the number 9, or which are the numbers 9.

Our invention was definitely not “patented or described in a printed publication in this of a foreign country or in the public use or on sale in this country, more than one year prior to the date of application for patent in the United States” as asserted in this Rejection.

We quote from the Preliminary Examination conducted by the U.S. Patent Office:

“Claims 1-20 meet all of the criteria set out in PCT Article 33(4), because the prior art does not teach or fairly suggest a device having all the limitations of claim 1. In

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particular, the prior art does not disclose or suggest that the four or more series on each piece are grouped into series pairs, where the numbers on each piece add up to nine, except for a piece where all numbers are nine.”

5. & 6. Claim Rejections – 35 USC § 103 Assertions:

“Hardenstein teaches game pieces with number indicia in four sections (Fig. 1C-F). on face. The only difference between the applicant’s tiles and the cited tiles resides in meaning and information conveyed by printed matter not considered patentable.” There are some additional assertions made in this section, which will be addressed after this main assertion is discussed.

5. & 6. Response:

The claims in Hardenstein support numerical matching of tiles, as in the game dominoes. For example a tile with a 2 on a side is placed next to another tile with a 2 on one of its sides.

Our invention is quite different. Our tiles are to be manufactured so that a tile placed next to another tile will continue at least two numerical series running between the two tiles, and on to others in both directions. This is a feature of the construction of the tiles and has nothing to do with extraneous printed information as asserted.

Fig. 6 above in Section “3. & 4.” shows nine tile designs. (Recall that in this embodiment the series run along the diagonals.) In the preferred embodiment no other tile designs are needed to create a complete game. Instead, these nine tiles are replicated a sufficient number of times to provide an adequate number of tiles for all players in the game. By following the transformations outlined in Section “3. & 4.” above, the replicated tiles can cover an arbitrarily large playing surface, still using only 9 tile designs. As the surface is covered with tiles, the numerical series remain intact in every direction, and the surface is fully covered because there are no gaps between tiles where tiles cannot be placed.

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Contrast this invention with that of Hardenstein, who has exactly 30 distinct tiles, with no replicas. The design of the tiles forces many spots where tiles cannot be placed. The surface cannot be filled. There are no numerical series intact.

These differences are properties of the manufacture of the tiles in the two inventions. No other extraneous material is required to formulate these conclusions concerning the number of tiles in the games, or their behavior when combined on a playing surface.

Another inherent difference between the two inventions is the contrast between the arbitrary nature of the Hardenstein pieces, and the singular nature of our pieces. Consider once again the nine tiles in Fig. 6. These nine tiles are the only nine tiles that can be manufactured that will create the preferred embodiment of our game. There are over 1.67 million different possible tiles, but only these 9 tiles can be replicated and transformed to preserve the multiple numerical series. That is less than 6 one-hundred-thousandths of one percent of all the possible tiles. The unique method of making the nine tiles is a significant, non-obvious invention. The construction of the Hardenstein tiles is considerably more arbitrary. There are many ways to construct the pieces in Hardenstein to obtain the desired game. There are significant differences in the game pieces of our invention when compared to those of Hardenstein. These differences are in the construction and structure of the tiles, not in the rules or other explanatory material.

In conclusion we would like to address the other assertion made in this section.

We agree with the assertion that a variety of indicia would ordinarily be adopted to appeal to various audiences for the games. We maintain we are correct in claiming those that we feel crucial to the success of the products. This prevents others from patenting games on trivial design improvements over our patent. Since our claimed indicia are both new and based on the validity of the preceding Claims in this patent, we believe they are valid Claims.

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7. Prior Art

We wish to thank the examiner for bringing to our attention two additional patents in the prior art. We have reviewed patents 2,383,081 and 490,689. Both cover matching games or puzzles, and in that sense are similar to Hardenstein. If it is possible, we would like to include the following new paragraph in our discussion of prior art:

“5600. Like the present invention, many games in the prior art are based on tiles. In most of these, the front surface of each tile is printed with indicia that guide the player in the placement of the tile during the game. It is very common to divide square tiles into four quadrants, with indicia in each. This division can be by diagonal lines from corner to corner, or by horizontal and vertical lines meeting at right angles in the center of the tile. In 490,689 to Thurston (1893) a puzzle is created from 8 tiles. Each tile is divided into four quadrants, with a different number in each quadrant. Both methods of division are suggested. To complete the puzzle the player must place each tile next to a tile with matching indicia along the common edge. In 1,666,448 to Hardenstein square tiles are matched as in 4-way dominoes, with complex scoring added. 2,383,081 to Ribbe is a card game of similar construction, but with pictures in place of the numbers. In 2,571,195 to Buck pieces that in some cases have only some quadrants colored in are matched to form geometric figures. Additional games elaborating on these ideas are found in 3,608,902 to Weisbecker where colored tiles are used as a board to guide the advancement of colored pieces, 3,680,866 to Kerr where rectangular pieces divided into four quadrants are used like dominoes, 4,463,952 to Rowbal where the game board has colors around the edge that must be matched by the colored quadrant of a tile and the tiles touching internally must also match colored quadrants, 4,659,085 to DeVries where square tiles marked with four numbers are played by matching like dominoes on a predetermined path around a board, and 4,673,185 to Morley where hexagonal pieces are divided into 6 sections, marked with colors or indicia and played like dominoes. Although building on basic aspects of the prior art, such as square and hexagonal tiles divided into colored sections, the present invention is distinct from the prior art in

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that the tiles are constructed not for matching but instead to form multiple numerical series.”

Sincerely,

Karla M. Blake

Karla Blake

Netherware Ltd

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